

REMARKS

This paper is submitted in response to the Office Action mailed April 7, 2006. The Applicant respectfully requests that the following Remarks be entered into the official file pertaining to the subject application.

Per this paper, claims 1-25 remain pending in the subject application.

Claims 1-25 stand rejected.

The following sections address *in seriatim* the points in the Office Action requiring response.

I. Rejection of Claims 1-5, 7-12, 14-21 and 23-24 under 35 U.S.C. § 103(a)

At paragraph 2, spanning pages 2-10 of the Office Action, the Examiner rejects claims 1-5, 7-12, 14-21 and 23-24 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 20040018853 to Lewis ("Lewis") in view of U.S. Patent Application Publication No. 20040249625 to Leaming ("Leaming"). The Applicant respectfully disagrees with the Examiner's rejection and asserts the following remarks in response:

In order for the Examiner to establish a *prima facie* case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the cited prior art references or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. Third, the prior art references must disclose or suggest all

of the claimed limitations. *See* MPEP 2143. The Examiner has failed to establish a *prima facie* case for obviousness because the Examiner failed to satisfy his burden of showing that the prior art discloses or suggests all of the claimed limitations of claims 1-5, 7-12, 14-21 and 23-24 and, as such, failed to satisfy his burden of showing that there is a suggestion or motivation to one of ordinary skill in the art to modify the primary reference as the Examiner proposes.

First, the Examiner wrongly bases his rejection under 35 U.S.C. § 103(a) on Lewis as the primary reference. Lewis is directed to a signal processor with a multimode receiver adapted to receive information relating to a plurality of service modes such as W-CDMA and GSM. (*See* page 5, paragraph [0043]). The signal processor utilizes a subscriber identity module (SIM) card that identifies a subscriber. (*See* page 1, paragraph [0009]). While Lewis discloses a configuration controller for configuring the reconfigurable logic means to support service modes (*See* pages 4-5, paragraph [0042]), Lewis fails to disclose that the SIM card provides any type of mode selection or configuration information and the Examiner has not met his burden showing otherwise. In contrast, Lewis discloses that “when an alternative mode is required, such as at system handover time or as a result of external events, the processor will reconfigure the reconfigurable logic as to be able to operate in the alternative modes.” (*See* page 5, paragraph [0043]). Thus, it is clear that Lewis does not teach, disclose or suggest providing any information by or retrieved from the SIM card or selecting a communication scheme from information provided by or retrieved from the SIM card.

Rather, there is an explicit teaching in paragraph [0043] of Lewis that any reconfiguration is based on external events, such as network support, available channels and network operational characteristics. Thus, it is clear that Lewis does not use the SIM card or a smart card to select and enable a communication scheme (see independent claim 1), to provide configuration information (see independent claims 11 and 24), to provide configuration instructions (see independent claims 16), or to designate respective programs for the IF section (see independent claim 19). Moreover, one of ordinary skill in the art would not have been motivated to modify the apparatus described by Lewis to include the patentable elements of Applicant's claimed apparatus, and the Examiner's rejection based upon Lewis as the primary reference is improper.

The Examiner alleges that Leaming supplies the missing elements of Lewis with only general references to Leaming. Incorporating the comments above regarding the inappropriate application of Lewis as the primary reference, Applicant respectfully disagrees with the Examiner's characterization that Leaming supplements the deficiencies of Lewis. For example, Leaming is directed to a smart card emulation system used to develop, test and debug new applications that may be used in a final smart card circuit. (See page 1, paragraph [0006]). The emulation system may be operatively connected to a smart card adapter or reader that is a portion of a host device. (See page 3, paragraph [0028]). The emulation system further comprises a mode detection circuit that detects the operational mode of the smart card adapter. (See page 2, paragraph [0018] and page 4, paragraph [0039]). Thus, it is clear that the emulation system is configured by the host device rather than by information from a smart card. Further, not only does

Leaming fail to disclose, teach or suggest that the host device is in any way configured by information provided by or received from a smart card, Leaming does not disclose, teach or suggest any method of dynamically configuring the host device or emulation system by a smart card.

Additionally, the Examiner does not provide any motivation to combine Leaming with Lewis. Rather than meeting his burden, the Examiner provides a general phrase consisting of “in a similar field of endeavor...” without providing any support therefor in the description of Leaming. In contrast, Leaming explicitly teaches that the apparatus described therein is applicable for detecting International Organization for Standardization (ISO) and Universal Serial Bus (USB) protocols (*See* page 1, paragraph [0003]) and may also be implemented with FireWire, Ethernet, BaseT, fiber optic, fiber channel protocols. (*See* page 6, paragraph [0067]). It is clear that there is no motivation in Leaming to combine the described apparatus with the field of endeavor of Lewis, and the Examiner’s suggestion otherwise is incorrect and unfounded.

Thus, the Examiner has not only failed to meet his burden of showing that the cited prior art references, alone or in combination, disclose or suggest each and every claimed feature, but he has also failed to satisfy his burden of showing that there is some suggestion or motivation to one of ordinary skill in the art to modify the primary reference Lewis by Leaming to render the claimed invention obvious. Furthermore, the combination of Lewis with Leaming does not disclose, teach or suggest Applicant’s claimed invention, as set forth in independent claims 1, 11, 16, 19, and 24. As such, Applicant respectfully requests that the Examiner reconsider and withdraw his rejection

of independent claims 1, 11, 16, 19 and 24 under 35 U.S.C. § 103(a) and allow the same to issue in a U.S. Patent.

Claims 2-5 and 7-10; claims 12 and 14-15; claims 17-18; claims 20-21 and 23 are dependent upon independent claims 1, 11, 16 and 19, respectively. Claims 1, 11, 16 and 19 are in condition for allowance. Thus, the claims depending from independent claims 1, 11, 16 and 19 are patentable at least by virtue of their dependence without need to resort to the additional patentable limitations contained therein. Reconsideration and withdrawal of the rejection of claims 2-5, 7-10, 12, 14-15, 17-18, 20-21 and 23 under 35 U.S.C. § 103(a) are hereby solicited.

II. Rejection of Claims 6, 13, 22 and 25 under 35 U.S.C. § 103(a)

At paragraph 3, spanning pages 10-12 of the Office Action, the Examiner rejects claims 6, 13, 22 and 25 under 35 U.S.C. §103(a) as allegedly being unpatentable over Lewis in view of Leaming and further in view of U.S. Patent Application Publication No. 20030214780 to Oh-Yang, et al. Without addressing the merits of the rejection, claims 6, 13, 22 and 25 are dependent upon independent claims 1, 11, 19 and 24, respectively. Claims 1, 11, 19 and 24 are in condition for allowance. Thus, the claims depending from independent claims 1, 11, 19 and 24 are patentable at least by virtue of their dependence without need to resort to the additional patentable limitations contained therein. Reconsideration and withdrawal of the rejection of claims 6, 13, 22 and 25 under 35 U.S.C. § 103(a) are hereby solicited.

CONCLUSION

This paper has been submitted responsive to the Office Action mailed April 7, 2006. Claims 1-25 remain pending in the subject application.

Applicant believes that the present application is now in condition for allowance and such action is earnestly requested.

Should any additional fees be necessary in connection with the filing of this Response, or if a petition for extension of time is required for timely acceptance of the same, such a petition is made and the Office is authorized to charge such fees to Deposit Account No. 04-1679.

Respectfully Submitted

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